UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/765,963 | 01/29/2004 | Kazuo Shiota | 2091-0309P | 2340 |

2292        7590        02/03/2009
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| EXAMINER |
|---|
| RASHID, DAVID |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2624 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 02/03/2009 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

| | Application No. | Applicant(s) |
|---|---|---|
| | 10/765,963 | SHIOTA ET AL. |
| **Office Action Summary** | Examiner | Art Unit | |
| | DAVID P. RASHID | 2624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on _11/20/2008_.

2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) _1,2,5,9,11-16 and 18-21_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1,2,5,9,11-16 and 18-21_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

### *Table of Contents*

### *Amendments & Claim Status*

**[1]**    This office action is responsive to <u>Amendment in Response to Non-Final Office Action</u>
received on Nov. 20, 2008.  Claims 1-2, 5, 9, 11-16, and 18-21 remain pending; claim 21 new.

### *Response to Arguments*

**[2]**    <u>Remarks</u> filed Nov. 20, 2008 with respect to claims 1-2, 5, 9, 11-16, and 18-21 have been
respectfully and fully considered, but are not found persuasive.

<u>*Summary of Remarks regarding Rejections under 35. U.S.C. § 103*</u>

> In contrast, claim 1, as amended, requires a qualified photographic image extracting means for
> extracting photographic images that satisfy previously stored predetermined selection conditions
> as qualified photographic images, from each of the similar photographic image groups, wherein
> the previously stored predetermined selection conditions relate to image quality. According to the
> disclosure of Kowald, the user reviews all of the images that satisfy the "long shot" request and
> selects an image.
>
> As the user is reviewing the whole set of images satisfying the search result and selecting images
> from the whole set of images, Applicants maintain that these teachings are insufficient to teach or
> suggest previously stored predetermined selection conditions. Further there is no disclosure that is
> directed to extracting photographic images that satisfy previously stored predetermined selection
> conditions as qualified photographic images, from each of the similar photographic image groups,
> wherein the previously stored predetermined selection conditions relate to image quality.

Applicant's <u>Remarks</u> at 9, Nov. 20, 2008.

        However, a user reviewing all the images that satisfy the "long shot" request and then

selecting an image does not include the full anticipation of *Kowald*.  To satisfy a "long shot"

request by the user, the images must have previously been classified (using metadata) such that
the user is able to request such a characteristic from the image group "long shot" (and hence why
classification items 522, 524 occur before the user edits in the video editing system item 514).
The metadata tagged to images under "long shot" from the classifier is interpreted as "previously
stored predetermined selection conditions". "Previously stored predetermined selection
conditions" can pertain to all metadata used in the classification process. In particular, those
metadata that specifically relate to "image quality" (e.g., metadata for "image quality analysis
(sharpness, colour, content quality, etc.)" at para.0053) are most relevant for the prior art
rejection.

Video editing system 514 (the "qualified photographic image extracting means") extracts
images upon user request through the use of metadata created out of the classification system
items 522, 524. Those images being extracted by the user (e.g., supposing the user wishes to
select images of e.g., sharpness = X, sharpness = X already being a previously stored
predetermined selection condition when classified at items 522, 524 to place the metadata)
satisfy previously stored predetermined selection conditions as qualified photographic images
(the classifier by creating metadata sharpness = X for those images that qualify),

The Examiner suggests further defining what a "previously stored predetermined
selection condition" is to differentiate from the current prior art of record.

### *Claim Rejections - 35 U.S.C. § 112*

[3]     The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

<u>New Matter</u>

> If new subject matter is added to the disclosure, whether it be in the abstract, the specification, or
> the drawings, the examiner should object to the introduction of new matter under 35 U.S.C. § 132
> or 251 as appropriate, and require applicant to cancel the new matter. If new matter is added to the
> claims, the examiner should reject the claims under 35 U.S.C. § 112, first paragraph - written
> description requirement. *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

M.P.E.P. § 2163.06(I).

**Claim 21** is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the
written description requirement. The claim(s) contains subject matter which was not described

in the specification in such a way as to reasonably convey to one skilled in the relevant art that
the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 21 (emphasis added) cites method-steps such as "determining <u>the total number</u> of
photographic images in each of the photographic image groups", "wherein when a total number
of photographic images in one photographic group <u>is larger than a predetermined threshold</u>", and
". . .that are set for photographic groups having <u>less than the predetermined threshold</u>"; however,
the original disclosure does not support comparing photographic groups to a predetermined
threshold (i.e., the use of a "predetermined threshold" is not supported in the original disclosure),
nor does the original disclosure support determining a total number of photographic images to
create such photographic image groups to be compared with a threshold (i.e., the determination
of a "total number" is not supported in the original disclosure).

### *Claim Rejections - 35 U.S.C. § 101*

[4]     35 U.S.C. § 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

*Judicial Exception – Abstract Idea*

**Claim 21** is rejected under 35 U.S.C. § 101 because the claimed invention is directed to
non-statutory subject matter.

A judicial exception claim is non-statutory for solely embodying an abstract idea, natural
phenomenon, or law of nature.  *See* M.P.E.P. § 2106(IV)(C)(2).  However, a practical application
of a judicial exception claim is a § 101 statutory claim "when it:

(A)    'transforms' an article or physical object to a different state or thing [(*i.e.*, a physical
transformation, see below)]; or

(B)    otherwise produces a useful, concrete and tangible result, based on the factors
discussed below. . . ."  *Id.*

§ 101 statutory transformations of intangible articles or physical objects must be <u>physical</u>
transformations (*i.e.*, a physical component to the transformation must be involved). [1]

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[1] *See* M.P.E.P. § 2106(IV)(C)(2) (requiring the element "provides a transformation or reduction of an article to a
different state of thing", a "practical application by physical transformation") *and* <u>Interim Guidelines for</u>

*In Re Bilski – "Tied To" Criteria*

[5]     **Claim 21** is rejected under 35 U.S.C. § 101 as not falling within one of the four statutory categories of invention.  Supreme Court precedent[2] and recent Federal Circuit decisions[3] indicate that a statutory "process" under 35 U.S.C. § 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing.  While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

         Claim 25 does not meet criteria (1) or (2) as the claim must be tied to an "apparatus" or "machine", and the tie must be meaningful (*i.e.,* a tie to insignificant pre- or post-solution activity in not meaningful, only a tie to the basic inventive concept).

## Claim Rejections - 35 U.S.C. § 103

[6]     The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

*Kowald in view of Khan et al.*

[7]     **Claims 1-2, 13-15,** and **18-20** are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pub. No. 2003/0002715 (filed Dec. 7, 2000, *hereinafter* "Kowald") in view of U.S. Pub. No. 2003/0126121 (filed Jun. 21, 2002, *hereinafteer* "Khan et al.").

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Examination of Patent Applications for Patent Subject Matter Eligibility, Official Gazette notice, 22 November 2005, Annex (II)(B)(iii); (III).
[2]  *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).
[3]  *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

Regarding **claim 1**, while *Kowald* discloses a photographic image
("photographer...capturing the image or image sequence." at ¶0037) selecting apparatus (fig. 5)
comprising:

a classifying means (fig. 5, items 522, 524; fig. 6, item 601) for classifying a plurality of
photographic images into similar photographic image groups ("[t]he visual language
classification system 522 outputs classification data 524, configured as further metadata, which
is associated with each image..." at ¶0036; metadata for "features including landscape
features...or other particular shapes..." at ¶0037; metadata for "time code and date data" at
¶0051), comprising photographic images which are similar to each other (photographic images in
a video stream are "similar" to each other), the similarities being determined by analyzing
("content analysis to analyse the images residing in the store 510", at ¶0037) digital data ("digital
video" at ¶0035) representing the photographic images;

a qualified photographic image extracting means (fig. 5, item 514; fig. 6, item 616) for
extracting ("editing system 514 which extracts the appropriate images or sequence of images
from the store 510" at ¶0047; ¶0048 for an example of "images that have been previously
classified as a long shot") photographic images, that satisfy previously stored predetermined
selection conditions (¶0050; e.g., images classified now containing metadata for "sharpness,
colour, content quality" at ¶0053 that were classified at items 522, 524) as qualified photographic
images (those images classified under a certain characteristic in memory 526 will be identified
for editing in video editing system 514), from each of the similar photographic image groups
(Each frame/image is tagged with metadata including all identified characteristics of that
particular frame. All frames/images with a particular metadata tag (*e.g.*, exposure amount) is a
group, and it is possible for each frame/image to belong to multiple groups. Hence, each of the
similar photographic image groups will be extracted in the editing system 514 when all images
are searched for a particular metadata characteristic.), wherein the previously stored
predetermined selection conditions related to image quality (¶0050; grouped metadata
"sharpness, colour, content quality" at ¶0053 from the classifier item 524 "relate" to image
quality); and

a differentiating and processing means (fig. 5, items 518, 519, 516; fig. 6, item 616) for
differentiating the qualified photographic images from the other photographic images (those

images classified under a certain characteristic in memory 526 will be identified for editing in
video editing system 514 is "differentiating" those images classified under a certain
characteristic from the rest) and administering processes thereon (those images classified under a
certain characteristic are then open for editing in system 514, and thus "administering processes
thereon"),

wherein:

the qualified photographic image extracting means (fig. 5, item 514; fig. 6, item 616) is
equipped with a selection condition setting means (fig. 5, item 514; "[t]he system 514 then
interrogates the store 526 to form a pick-list of images…" at ¶0048; ¶0048),

the selection condition setting means sets the selection conditions for each similar
photographic image group (fig. 5, item 514 is responsible for selecting the set for each similar
photographic image group; ¶0048); and

a recording means (fig. 5, items 504, 510, 526, and 519 are all recording means for
storing the image data) for recording the differentiated photographic images (those images
classified under a certain characteristic in memory 526 will be identified for editing in video
editing system 514 is "differentiating" those images classified under a certain characteristic from
the rest), *Kowald* does not teach the selection condition setting means so as to be stricter for
photographic image groups having a greater number of photographic images included therein.

*Khan et al.* discloses a method for remotely searching biometric data (including face
recognition) that includes a selection condition setting means (fig. 10) that sets the selection
conditions for each similar photographic image group ("photographs of a group of individuals of
interest" at ¶0023), so as to be stricter for similar image photographic image groups having a
greater number of photographic images included therein ("[a]lternatively, the search engine may
be programmed by the user to select a predetermined number of top matches and send those to
the workstation (1026" at ¶0052; if a predetermined number of top matches is selected (*e.g.,* 10),
then the more images in a given group would have to have stricter rules because only 10 must be
selected (*i.e.,* selecting 10 images from a group of 100 images would not incorporate as many
strict rules needed for selecting 10 images from a group of 1000 images).

It would have been obvious to one of ordinary skill in the art at the time the invention
was made for the selection condition setting means of *Kowald* to include so as to be stricter for

photographic image groups having a greater number of photographic images included therein as taught by *Khan et al.* "to provide a system and method for searching biometric data over a network", *Khan et al.*, ¶0009 and "to provide a system and method that uses the Internet as a communication infrastructure to enable time and cost-effective information sharing of biometric information between organizations", *Khan et al.*, ¶0010.

Regarding **claim 2**, *Kowald* discloses wherein:

the predetermined selection conditions include image quality levels ("image quality analysis" in ¶0053]).

Regarding **claim 13**, *Kowald* discloses wherein:

the differentiating and processing means (fig. 5, items 518, 519, 516; fig. 6, item 616) performs processes wherein the qualified photographic images and the other photographic images are differentiated (¶0047]), then recorded in the recording means (fig. 5, item 519), the qualified photographic images being stored separately from the other photographic images (memory is comprised of addresses, specific addresses containing information for specific images; qualified photographic images are "stored separately" with respect to their address locations from the other photographic images, even if all images are stored in the same memory).

Regarding **claim 14**, *Kowald* discloses wherein:

the differentiating and processing means (fig. 5, items 518, 519, 516; fig. 6, item 616) performs processes wherein only the qualified photographic images are recorded (from ¶0036], the video editing system 514 grabs only the frames/images from database 510 that pertain to metadata characteristics stored in database 526 to be further processed in items 516, 518, 519) in a recording medium (fig. 5, item 519; ¶0036]).

Regarding **claim 15**, *Kowald* discloses wherein:

the differentiating and processing means (fig. 5, items 518, 519, 516; fig. 6, item 616) is a display means (fig. 5, item 518); and

only the qualified photographic images are displayed (from ¶0036], the video editing system 514 grabs only the frames/images from database 510 that pertain to metadata characteristics stored in database 526 to be further processed in items 516, 518, 519) thereby.

Regarding **claim 18**, claim 1 recites identical features as in the computer readable medium having recorded therein a program that causes a computer to execute selection of

photographic images (fig. 6; ¶0062) of claim 18. Thus, references/arguments equivalent to those presented above for claim 1 are equally applicable to claim 18.

Regarding **claim 19**, *Kowald* discloses the photographic image selecting apparatus of claim 1, wherein the qualified photographic image extracting means (fig. 5, item 514; fig. 6, item 616) extracts ("editing system 514 which extracts the appropriate images or sequence of images from the store 510" at ¶0047; ¶0048 for an example of "images that have been previously classified as a long shot") photographic images that satisfy predetermined selection conditions (¶0050; "sharpness, colour, content quality" at ¶0053) , said predetermined selection conditions being based on image quality (¶0050; "sharpness, colour, content quality" at ¶0053).

Regarding **claim 20**, *Kowald* discloses the photographic image selecting apparatus of claim 1, wherein the predetermined selection conditions (¶0050; "sharpness, colour, content quality" at ¶0053) are related to at least one of degree of exposure, degree of defocus, degree of blur ("<u>sharpness</u>, colour, content quality" at ¶0053, *emphasis added*), degree of defocus of a facial portion, and whether an eye of a subject being photographed is open.

*Kowald in view of Khan et al. and Bhatt*

[8]     **Claims 5** and **9** are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kowald* in view of *Khan et al.* and U.S. Pub. No. 2002/0118883 (filed Feb. 24, 2001, *hereinafter* "Bhatt").

Regarding **claim 5**, while *Kowald* in view of *Khan et al.* discloses a photographic image selecting apparatus as defined in claim 3, *Kowald* in view of *Khan et al.* does not teach wherein the selection condition setting means sets the selection conditions so that at least one qualified photographic image is extracted from each of the similar photographic image groups.

*Bhatt* discloses a classifier-based enhancement of digital image (fig. 5) wherein a selection condition setting means sets the selection conditions (fig. 5, items 40, 45, 50, 65, 55) so that at least one qualified photographic image (¶0032; fig. 5, item 20, "photo quality" in ¶0008) is extracted ("Each image after enhancement goes through a file size check in item 45." in ¶0032; ¶0032) from each of the similar photographic image groups ("Image Enhance GROUP 1" through "Image Enhance GROUP N" in fig. 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the selection condition setting means of *Kowald* in view of *Khan et al.* to include setting the selection conditions so that at least one qualified photographic image is extracted from each of the similar photographic image groups as taught by *Bhatt* "…to provide a novel automated method with minimal manual interactions to enhance the images from diverse sources.", *Bhatt*, ¶0009.

Regarding **claim 9**, while *Kowald* in view of *Khan et al.* discloses a photographic image selecting apparatus as defined in claim 3, *Kowald* in view of *Khan et al.* does not disclose wherein the selection condition setting means sets the selection conditions according to a specified number of qualified photographic images to be extracted from each of the similar photographic image groups.

*Bhatt* discloses a classifier-based enhancement of digital image (fig. 5) wherein a selection condition setting means (fig. 5, items 40, 45, 50, 65, 55) sets the selection conditions (fig. 5, item 65; "parameters" in ¶0032; ¶0032) according to a specified number (the specified number is all images in each Image Enhance GROUP, whatever that number may be) of qualified photographic images (¶0032; fig. 5, item 20, "photo quality" in ¶0008) to be extracted from each of the similar photographic image groups ("Image Enhance GROUP 1" through "Image Enhance GROUP N" in fig. 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the selection condition setting means of *Kowald* in view of *Khan et al.* to include setting the selection conditions according to a specified number of qualified photographic images to be extracted from each of the similar photographic image groups as taught by *Bhatt* "…to provide a novel automated method with minimal manual interactions to enhance the images from diverse sources.", *Bhatt*, ¶0009.

*Kowald in view of Khan et al. and Kowald.*

[9]     **Claim 11** is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kowald* in view of *Khan et al.* and *Kowald*.

Regarding **claim 11**, while *Kowald* in view of *Khan et al.* discloses a photographic image selecting apparatus as defined in claim 1, wherein *Kowald* discloses:

the differentiating and processing means (fig. 5, items 518, 519, 516; fig. 6, item 616) performs processes wherein only the qualified photographic images (from ¶0036], the video editing system 514 grabs only the frames/images from database 510 that pertain to metadata characteristics stored in database 526 to be further processed in items 516, 518, 519) are processed (fig. 5, items 518, 519), *Kowald* in view of *Khan et al.* does not teach wherein that processing is printing.

    *Kowald* teaches a printer (fig. 6, item 615) connected to the photographic image selecting apparatus (fig. 6, item 601).

    It would have been obvious to one of ordinary skill in the art at the time the invention was made for the differentiating and processing means of *Kowald* in view of *Khan et al.* to include a printer as taught by *Kowald* for "…the automated classification of images and/or shots into various emotive catgories thereby permitting editing to achieve a desired emotive effect.", *Kowald*, ¶0016.

*Kowald in view of Khan et al. and Kowald and Sano*

**[10]**    **Claim 12** is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kowald* in view of *Khan et al.*, *Kowald*, and U.S. Patent No. 6,079,885 (issued Jun. 27, 2000, *hereinafter* "Sano").

    Regarding **claim 12**, while *Kowald* in view of *Khan et al.* discloses a photographic image selecting apparatus as defined in claim 1, wherein *Kowald* discloses:

    the differentiating and processing means performs process wherein the qualified photographic images and the other photographic images are processed (If two metadata characteristics are extracted from video editing system 514, groups A and B are formed-slides with characteristics of one metadata (group A) and slides with characteristics of the other metadata (group B). All slides with both metadata characteristics are processed (groups A and B), and if group A is the "qualified photographic images" with respect to one metadata characteristic, then group B would be the "other photographic images".), *Kowald* does not teach wherein the process is (i) <u>printing</u> (ii) in <u>different</u> sizes.

    *Kowald* teaches a printer (fig. 6, item 615) connected to the photographic image selecting apparatus (fig. 6, item 601).

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the differentiating and processing means of *Kowald* in view of *Khan et al.* to include a printer for printing as taught by *Kowald* for "…the automated classification of images and/or shots into various emotive categories thereby permitting editing to achieve a desired emotive effect.", *Kowald*, ¶0016.

*Sano* discloses a printer with variable image processing corresponding to image size (fig. 1) wherein photographic images (3:28 - 29) are printed in different sizes ("image 1" and "image 2" in fig. 6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the differentiating and processing means and printer of *Kowald* in view of *Khan et al.* and *Kowald* to include printing the qualified photographic images and the other photographic images of *Kowald* in view of *Khan et al.* and *Kowald* in different sizes as taught by *Sano* "…to produce high quality prints by changing the type of image processing and the amount of correction corresponding to the size of each printed image.", *Sano*, 2:3-5.

### *Kowald in view of Khan et al and Tsukagoshi et al.*

[11]   **Claim 16** is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kowald* in view of *Khan et al.* and U.S. Patent No. 5,848,217 (issued Dec. 8, 1998, *hereinafter* "Tsukagoshi et al.").

Regarding **claim 16**, while *Kowald* in view of *Khan et al.* discloses a photographic image selecting apparatus as defined in claim 1, wherein *Kowald* discloses:

the differentiating and processing means (fig. 5, items 518, 519, 516; fig. 6, item 616) is a slideshow display means (fig. 5, item 518 wherein a display constitutes a "slideshow"); and

the qualified photographic images and the other photographic images (If two metadata characteristics are extracted from video editing system 514, groups A and B are formed-slides with characteristics of one metadata (group A) and slides with characteristics of the other metadata (group B). All slides with both metadata characteristics are displayed (groups A and B), and if group A is the "qualified photographic images" with respect to one metadata characteristic, then group B would be the "other photographic images".) are displayed as slides

for display durations, *Kowald* in view of *Khan et al.* does not teach displaying <u>different</u>
durations.

    *Tsukagoshi et al.* discloses subtitle encoding/decoding method and apparatus (fig. 1)
wherein slides ("plurality of video frames" in 6:23-39) are displayed in different durations (6:23-
39 wherein subtitles are longer in time duration that the video frame).

    It would have been obvious to one of ordinary skill in the art at the time the invention
was made for slideshow display means of *Kowald* in view of *Khan et al.* to display the slides at
different display durations as taught by *Tsukagoshi et al.* "for encoding subtitles to be played
back exclusively during the trick playback mode, i.e., during fast, slow or reverse playback
modes.", *Tsukagoshi et al.*, 2:61-64.

### Conclusion

[1]    Applicant's amendment necessitated the new ground(s) of rejection presented in this
Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).
Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

    A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
MONTHS of the mailing date of this final action and the advisory action is not mailed until after
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R.
§ 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,
will the statutory period for reply expire later than SIX MONTHS from the date of this final
action.

[12]    Any inquiry concerning this communication or earlier communications from the
examiner should be directed to DAVID P. RASHID whose telephone number is (571)270-1578.
The examiner can normally be reached Monday - Friday 7:30 - 17:00 ET.

    If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Vikkram Bali can be reached on (571) 272-74155. The fax phone number for the
organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David P. Rashid/
Examiner, Art Unit 2624


/Bhavesh M Mehta/                                  David P Rashid
Supervisory Patent Examiner, Art Unit 2624        Examiner
                                                  Art Unit 26244